

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Baxter, Bradley James

**For: DEFORMATION ELEMENT FOR A
VEHICLE DASHBOARD**

Serial No.: 10/709,743

Filed: May 26, 2004

Group Art Unit: 3616

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Faye M. Fleming
Examiner

Dear Sir:

Appellant respectfully requests review of the final rejection mailed by the Office for the above-referenced application on May 23, 2007 (the "Final Office Action").

A Notice of Appeal is being filed concurrently herewith. This Request for Review is pursued for the reasons presented in the following pages.

Status of Claims

Claims 1-30 are currently pending in the application. In the Final Office Action, claims 1-30 were rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner stated that the patent application does not support the recitation of a generally S-shape. Claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26, and 28-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent 6,170,872 ("Bair et al."). Claims 12-15, 20, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by international patent application publication number WO 93/23626 ("Pomero"). Claims 7-9, 17-19, and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable and obvious over Bair et al. in view of United States Patent 5,951,045 ("Almefelt et al."). Finally, claims 3, 4, 13, 14, 21, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bair et al. in view of Pomero. Appellant believes these rejections to be in error, believes that the claims are allowable over the prior art, and respectfully requests that the pending rejections to the claims be withdrawn.

The application supports the recitation of a generally S-shape

The original claims recited "a first deformation member having a curved shape with at least first and second opposing radii of curvature in the direction of a deformation axis," which is the very definition of an S shape. Paragraph 22 of the specification defines the deformation members as "double curved members." Paragraph 23 describes the "S" shape precisely. A first deformation member 48 is shaped to have an upper lever arm 56 that joins an upper curve 60, which joins an upper middle lever arm 64. The lower middle lever arm 66 joins lower curve 72, which joins lower lever arm 76. Figure 3 clearly shows the "S" shaped deformation member described by the specification. Accordingly, the specification and figures clearly support the recitation of the deformation element being "S" shaped and the rejection under 35 U.S.C. § 112, first paragraph, is believed to be in error.

The Bair et al. reference fails to set forth each and every element and recitation of claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26, and 28-30

The Bair et al. reference shows a deformation element comprising two "C" shaped elements connected to form a cavity. This stands in stark contrast to the claimed structure, which includes a first deformation element, having first and second opposing radii of

curvature in the direction of a deformation axis forming a generally “S” shape, and a second deformation member that, when interconnected with the first deformation member, defines at least first and second deformation cavities. The Bair et al. reference does not set forth at least these elements and recitations. The Examiner’s suggestion that two of the “C” shaped members from the Bair et al. device “form an S shape when taken together” is improper as it redefines the prior art using the applicant’s disclosure. Accordingly, Bair et al. cannot anticipate claims 1, 2, 5, 6, 10-12, 15, 16, 20, 22, 26, and 28-30 under 35 U.S.C. § 102(b).

The Pomero reference fails to set forth each and every element and recitation of claims 12-15, 20, and 21

Pomero provides circular deformation elements, which are similar to the “C” shaped elements associated with Bair et al. Accordingly, Pomero is clearly distinguishable for the reasons set forth above with respect to Bair et al. Pomero fails to teach a first deformation element, having first and second opposing radii of curvature in the direction of a deformation axis forming a generally “S” shape, and a second deformation member that, when interconnected with the first deformation member, defines at least first and second deformation cavities. The Examiner’s argument that the “8” shape exhibited by the Pomero device “is two superimposed S’s is improper as it redefines the prior art using the applicant’s disclosure. Pomero, therefore, cannot anticipate claims 12-15, 20, and 21 under 35 U.S.C. § 102(b).

The Bair et al. and Almefelt et al. references fail to teach or otherwise suggest elements that would support an obviousness-type rejection of claims 7-9, 17-19, and 23-25

Almefelt et al. is produced by the Examiner to teach the use of flanged connections. However, Almefelt et al., Bair et al. and Pomero all fail to teach or otherwise suggest the claimed structural orientation of the two deformation members, as discussed herein. As such, the cited prior art fail to support an obviousness-type rejection of claims 7-9, 17-19, and 23-25.

The Bair et al. and Pomero references fail to teach or otherwise suggest elements that would support an obviousness-type rejection of claims 3, 4, 13, 14, 21, and 27

The Examiner is not considering the claimed invention or the prior art as a whole. In determining the difference between the prior art and the claims, the question under 35 U.S.C.

§ 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A prior art reference and the claimed invention must be considered in their entireties. Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S. 851 (1984). An energy absorbing structure comprising a first deformation element, having first and second opposing radii of curvature in the direction of a deformation axis forming a generally "S" shape, and a second deformation member that, when interconnected with the first deformation member, defines at least first and second deformation cavities is clearly unique to the art. No suggestion or motivation can be found within the art for such a device. Accordingly, claims 3, 4, 13, 14, 21, and 27 are believed to be patentable over the cited prior art.

CONCLUSION

In light of the arguments presented above, the Appellant respectfully submits that the instant claims are patentable. Accordingly, reconsideration and allowance of this Application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Dated: 01 Aug 07

HOLLAND & HART LLP
555 17th Street, Suite 3200
Denver, Colorado 80201
Telephone: (303) 295-8170
Facsimile: (303) 295-8261

Respectfully Submitted,

By: [Signature]

Shane M. Niebergall
Attorney for Appellant
Registration No. 44,974